

REMARKS

This Response is submitted in reply to the Final Office Action dated April 3, 2008. Claims 1 to 4, 6, 8 to 12, 14 to 18, 20, 21, 23, and 25 have been amended. No new matter has been added by these amendments. A Request for Continued Examination is submitted herewith. Please charge deposit account 02-1818 for any fees which are due in connection with this Request for Continued Examination and this Response.

As noted above, Applicant has filed a Request for Continued Examination with this Response. Accordingly, Applicant requests that the Examiner provide an upcoming Office Action which will ". . . identify any claims which he or she judges, as presently recited, to be allowable and/or . . . suggest any way in which he or she considers that rejected claims may be amended to make them allowable" in accordance with §707.07(d) of the MPEP.

The Office Action rejected Claims 1 to 4, 6, 9 to 12, 14, 21, 22, and 25 under 35 U.S.C. 102(b) as being anticipated by WO 98/09259 to Bennett.

Bennett discloses a slot machine that displays a tic-tac-toe game. The slot machine includes a plurality of player selectable zones and prizes associated with at least one of the zones. The slot machine displays an indicia in a zone selected by a player, the indicia being representative of the prize, if any, associated with that zone. The slot machine enables the player to select one or more zones to produce a game result. In the event that the game result is a winning result, the slot machine awards the prizes indicated by the indicia revealed in the zones selected by the player. In certain versions, the slot machine will include some zones which have a zero prize value such that if randomly selected by the controller and selected by the player, no prize is awarded to the player.

Amended independent claim 1 is directed to a gaming device including a display device, an input device, and a processor in communication with the display device and the input device. The processor programmed, for each play of a game, to: (a) cause a plurality of masked selections to be displayed to a player by the display device, (b) associate a plurality of different values with the masked selections prior to the masked selections being picked by the player and without displaying which values are

associated with which selections, (c) enable the player to pick a plurality of the masked selections for a designated number of predetermined sets, the designated number being at least two, (d) for each of the designated number of predetermined sets, determine a plurality of the values in the set by enabling the player to pick a plurality of the selections for the set, wherein the plurality of values in each set are based on the values associated with the selections picked by the player for the set, (e) cause a display of each of the predetermined sets and the values in each set, (f) generate at least one award by selecting, for each one of the predetermined sets, at least one but not all of the plurality of values in the predetermined sets, and (g) provide the award to the player.

Applicant submits that Bennett does not disclose a gaming device that includes the processor programmed, for each play of a game, to: enable the player to pick a plurality of the masked selections for a designated number of predetermined sets, the designated number being at least two. In Bennett, a slot machine enables the player to select one or more zones in a tic-tac-toe game. Page 4 of the Office Action interpreted a plurality of the player selections in the tic-tac-toe game of Bennett as a set of the gaming device of amended independent claim 1. That is, under the Office Action's interpretation, a set in the game of Bennett is formed as the player makes a plurality of selections in the tic-tac-toe game. Thus, a set in the game of Bennett is not determined until after a player makes a plurality of selections. On the other hand, the gaming device of amended independent claim 1 includes, amongst other elements, the processor programmed, for each play of a game, to: enable the player to pick a plurality of the masked selections for a designated number of predetermined sets, the designated number being at least two.

Applicant further submits that even if Bennett is interpreted such that the rows or columns displayed in the game of Bennett are predetermined sets of the gaming device of amended independent claim 1, the slot machine of Bennett does not disclose the processor programmed, for each play of a game, to: for each of the designated number of predetermined sets, determine a plurality of the values in the set by enabling the player to pick a plurality of the selections for the set. In Bennett, the player and the slot

machine alternate selecting zones until a winning tic-tac-toe event occurs (i.e., a predetermined number of identical game markers are displayed horizontally, vertically, or diagonally adjacent to each other in the zones). Based on the operation of the tic-tac-toe game in Bennett, different plays of the game of Bennett will result in the player and the slot machine selecting different zones and thus the same zones are not selected by the player and the slot machine for each game played. That is, if a row in the game of Bennett is a predetermined set, Bennett does not disclose the player selecting the zones in the same row for each play of the game (i.e., without the slot machine intervening and selecting a zone in the same row to block the player's selection of each zone in the same row). On the other hand, the gaming device of amended independent claim 1 includes, amongst other elements, the processor programmed, for each play of a game, to: for each of the designated number of predetermined sets, determine a plurality of the values in the set by enabling the player to pick a plurality of the selections for the set.

Moreover, as previously stated in the Response to Office Action dated December 11, 2007, Applicant resubmits that Bennett does not disclose a gaming device that includes a processor programmed, for each play of a game, to: generate at least one award by selecting, for each one of the predetermined sets, at least one but not all of the plurality of values in the predetermined set. In the Remarks section, the Office Action set forth an interpretation of a zero prize value selection in the game of Bennett as selecting at least one but not all of the plurality of values in each one of the sets of the gaming device of amended independent claim 1. The Office Action reasoned that in Bennett, if a player selects a plurality of values including a value of zero and the plurality of values are summed to produce a total award value, the zero value does not affect the total award value. That is, a selected zero value in the gaming device of Bennett produces the same award value as generating at least one award by selecting, for each one of the predetermined sets, at least one but not all of the plurality of values in the set of the gaming device of amended independent claim 1. However, regardless of whether Bennett can be interpreted to produce the same award value as amended independent claim 1, to anticipate amended independent claim 1, Bennett must disclose each and

every feature of amended independent claim 1. By the Office Action's admission, Bennett determines the award by summing all of the player's selected values (i.e., including the zero value). Moreover, if the player's selections do not include a zero value in the game of Bennett, the Office Action's interpretation of the game of Bennett fails because the sum of all of the player's selected values of Bennett will produce an award value that is different from an award determined by selecting, for each one of the predetermined sets, at least one but not all of the plurality of values. Thus, Bennett does not determine an award by selecting, for each one of the predetermined sets, at least one but not all of the plurality of values in the predetermined set. On the other hand, amended independent claim 1 includes, amongst other elements, a processor programmed, for each play of a game, to: generate at least one award by selecting, for each one of the predetermined sets, at least one but not all of the plurality of values in the predetermined set. Accordingly, for at least these reasons, Applicant submits that amended independent claim 1 is patentably distinguished over Bennett and is in condition for allowance.

Claims 2 to 4 depend directly from amended independent claim 1 and are also allowable for the reasons given with respect to amended independent claim 1 and because of the additional features recited in these claims.

The gaming devices of amended independent claims 6, 9, and 14 each includes certain elements similar to certain elements of amended independent claim 1. For reasons similar to the reasoning discussed above with respect to amended independent claim 1, amended independent claims 6, 9, and 14 (and dependent claims 10 to 12 respectively) are each patentably distinguished over Bennett and are in condition for allowance.

Amended independent claim 21 is directed to a gaming device that includes, amongst other elements, a processor programmed, for each play of a game, to: (1) display a plurality of masked selections, wherein the masked selections are associated with a plurality of values prior to the masked selections being picked by the player and without displaying which values are associated with which selections, and wherein the

associated values are each greater than zero, and (2) generate an award by selecting at least one but not all of the values in at least one set.

Applicant submits that Bennett does not disclose a gaming device that includes a processor programmed, for each play of a game, to: display a plurality of masked selections, wherein the masked selections are associated with a plurality of values prior to the masked selections being picked by the player and without displaying which values are associated with which selections, and wherein the associated values are each greater than zero. As discussed above, Bennett discloses a slot machine that enables the player to select zones in a tic-tac-toe game. In Bennett, some of the zones are associated with zero prize values. Thus, in Bennett, each of the plurality of zones are not associated with values that are greater than zero. On the other hand, the gaming device of amended independent claim 21 includes, amongst other elements, a processor programmed, for each play of a game, to: (1) display a plurality of masked selections, wherein the masked selections are associated with a plurality of values prior to the masked selections being picked by the player and without displaying which values are associated with which selections, and wherein the associated values are each greater than zero. Moreover, modifying Bennett such that each of the plurality of zones are associated with values greater than zero would destroy the intended purpose of Bennett and would thus be improper.

Additionally, Bennett does not disclose a gaming device that includes a processor programmed, for each play of a game, to generate an award by selecting at least one but not all of the values in at least one set. As described above with respect to amended independent claim 1, Bennett determines the award by summing all of the player's selected values (i.e., including the zero value). If the player's selections do not include a zero value in the game of Bennett, the Office Action's interpretation of the game of Bennett fails because the sum of all of the player's selected values of Bennett will produce an award value that is different from an award determined by selecting at least one but not all of the plurality of values. Thus, Bennett does not generate an award by selecting at least one but not all of the values in at least one set. On the other hand, the gaming device of amended independent claim 21 includes, amongst other

elements, a processor programmed, for each play of a game, to: generate an award by selecting at least one but not all of the values in at least one set. Moreover, modifying Bennett to produce an award by summing less than all of the player's selected values would destroy the intended purpose of Bennett and would thus be improper. Accordingly, for at least these reasons, Applicant submits that amended independent claim 21 is patentably distinguished over Bennett and are in condition for allowance.

Claim 22 depends directly from amended independent claim 21 and is also allowable for the reasons given with respect to amended independent claim 21 and because of the additional features recited in this claim.

The gaming device of amended independent claim 25 includes certain elements similar to certain elements of amended independent claim 21. For reasons similar to the reasoning discussed above with respect to amended independent claim 21, amended independent claim 25 is patentably distinguished over Bennett and is in condition for allowance.

The Office Action rejected claims 8, 15 to 20, 23, and 24 under 35 U.S.C. 103(a) as being anticipated by Bennett in view of U.S. Patent No. 6,345,824 to Selitzky.

The Office Action stated that Bennett does not disclose selecting at least one but not all of the awards from the plurality of different sets in order to generate a resulting award. The Office Action relied on Selitzky to disclose a game with a bonus feature wherein if the player's hand includes more than one bonus combination, only the highest ranking bonus combination is rewarded. The Office Action concluded that it would have been obvious to one of ordinary skill in the art to apply "only awarding the highest ranking bonus combination" as disclosed in Selitzky into the gaming machine of Bennett to provide more frequent, but smaller awards in Bennett without the need to pay large awards.

The gaming devices of amended independent claims 8 and 23 each includes certain elements similar to certain elements of amended independent claim 21. Applicant submits that regardless of whether or not it would have been obvious to incorporate Selitzky with Bennett, the gaming device resulting from the combination of Bennett and Selitzky discloses a gaming device wherein each of the plurality of zones

are not associated with values that are greater than zero. Thus, for reasons similar to the reasoning discussed above with respect to amended independent claim 21, amended independent claims 8 and 23 (and dependent claim 24) are each patentably distinguished over Bennett in view of Selitzky and are in condition for allowance.

The gaming devices of amended independent claims 15, 16, and 18 each includes certain elements similar to certain elements of amended independent claim 1. Applicant submits that regardless of whether or not it would have been obvious to incorporate Selitzky with Bennett, the gaming device resulting from the combination of Bennett and Selitzky discloses a gaming device where a set is not determined until after a player makes a plurality of selections. Thus, for reasons similar to the reasoning discussed above with respect to amended independent claim 1, amended independent claims 15, 16, and 18 (and dependent claims 17 and 19 to 20) are each patentably distinguished over Bennett in view of Selitzky and are in condition for allowance.

The Office Action rejected claim 7 under 35 U.S.C. 103(a) as being anticipated by Bennett in view of Official Notice.

The Office Action stated that Bennett does not disclose that the display device displays selections and reveals values associated with the selections that are not picked by the player. The Office Action relied on Official Notice to disclose that "it was notoriously well known in the art at the time of invention to display the non-chosen values, in addition to the chosen values." The Office Action concluded that one of ordinary skill in the art at the time of the invention would have been motivated to do so in order to indicate to the player what could have been selected.

Applicant submits that regardless of whether it was well known in the art at the time to display the non-chosen values, in addition to the chosen values, Bennett does not disclose a processor programmed, for each play of a game, to: enable the player to pick a plurality of the masked selections for a designated number of predetermined sets, the designated number being at least two. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Bennett in view of Official Notice to result in such a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand the gaming device of claim 7 includes, amongst

other elements, a processor programmed, for each play of a game, to: enable the player to pick a plurality of the masked selections for a designated number of predetermined sets, the designated number being at least two. Accordingly, for this reason and the reasoning provided with respect to amended independent claim 6, Applicant respectfully submits that claim 7 is patentably distinguished over Bennett in view of Official Notice and is in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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